Question Q217

National Group: Germany

Title: **The patentability criterion of inventive step / non-obviousness**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

Pursuant to Art. 56, sentence 1, EPC, an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art [in the German version: gilt eine Erfindung als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt].1 The wording of Sec. 4, sentence 1, German Patent Act is identical. The English and French versions of the EPC use the terms “not obvious”2 and “ne découle pas d'une manière évidente”3, however, a meaning deviating from the German version is not apparent from these semantic differences. The legal definition of inventive step therefore refers to the vague term of “obviousness” for the likewise undefined “person skilled in the art”. In German literature and case law, this fictitious person skilled in the art is also often referred to as the “average person skilled in the art” in order to suggest that this person skilled in the art in any case should not have above-average knowledge and skill.

[1] See in this connection the report of the regional group regarding question Q213 - The Person of Average Skill in Connection with the Requirement of Inventive Step in Patent Law

[2] “An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.”

[3] “Une invention est considérée comme impliquant une activité inventive si, pour un homme du métier, elle ne découle pas d'une manière évidente de l'état de la technique.”

As the Federal Court of Justice (FCJ) emphasized in particular in its recent case law4 the question of obviousness for the person skilled in the art and thus the question of inventive step is a question of law. “The assessment of whether the solution according to the invention was obvious to the person skilled in the art according to his established knowledge and skill is ... not the task of the expert, but is incumbent on the Court as an act of evaluatory recognition ... The Court has to study all of the factual circumstances which are suited - directly or indirectly - to reveal something regarding the requirements for finding the solution according to the invention.”

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

In general, fundamental changes with regard to the approach towards the examination of inventive step have not been apparent in the past 20 years.5

In Germany, focus was placed on whether the person skilled in the art could find the claimed subject matter using his knowledge and skill on the basis of the prior art when considering this as a whole6. In the more recent case law, the FCJ has taken a more formalized approach in which focus is placed on whether the person skilled in the art had a motivation to further develop the prior art in the direction of the claimed subject matter7. “[There must as a rule be, except] in those cases in which the skilled person sees immediately what is to be done, additional impulses, stimuli, suggestions or other motives going beyond the discernability of the technical problem to prompt the skilled person to look for the solution to the technical problem by way of the invention.”8

There have been important changes for computer-implemented inventions: While the Federal Court of Justice has recently placed lower requirements on the technicity of a computer-implemented invention with technical and non-technical features9, the criteria regarding the examination for inventive step have been tightened: While the entire subject matter of the invention (i.e. technical and non-technical features including a possible calculation rule) was considered until this time10, now11 only those instructions are to be taken as a basis when examining inventive step which determine or at least influence the solution of the technical problem with technical means.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

The German Patent and Trademark Office publishes Guidelines for the Examination of Patent Applications (Prüfungsrichtlinien).12 Section 3.3.3.2.4 thereof describes the procedure for carrying out an examination for inventive step. The examiners are obliged to examine patent applications in

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[4] FCJ - X ZR 162/00 - Diabehältnis, FCJ - X ZR 213/01 – Vorausbezahlte Telefongespräche, X

[5] Changes with respect to this have become apparent according to more recent case law for the assessment of inventive step of a utility model. In this regard .... the principles developed in patent law can be used. (FCJ - X ZB 27/05 (Federal Patent Court) - Demonstrationsschrank)

[6] Asendorf/Schmidt in Benkard, Patent Act and Utility Model Act, 10th edition, Munich (C. H. Beck) 2006, Sec. 4, marginal no. 18

[7] FCJ - Xa ZR 92/05 - Betrieb einer Sicherheitseinrichtung, FCJ– X ZR 65/05 – Einteilige Öse, X ZR 27/04 - Stahlblech

[8] FCJ – Xa ZR 92/05 – Betrieb einer Sicherheitseinrichtung

[9] FCJ, decision of 22 April 2010 – Xa ZB 20/08 (Federal Patent Court) – Dynamische Dokumentengenerierung

[10] FCJ, Judgment of 4 February 1992 – X ZR 43/91 (Federal Patent Court) – “Tauchcomputer”

[11] FCJ, Judgment of 26 October 2010 – X ZR 47/07 (Federal Patent Court) – “Wiedergabe topografischer Informationen”

[12] BlPMZ 2004, 69; http://www.dpma.de/docs/service/formulare/patent/p2796.pdf

accordance with the Guidelines. However, amendments and the development of case law as well as the particularities of individual cases are to be taken into consideration.

The European Patent Office (EPO) publishes Guidelines for Examination in the European Patent Office.13 The examination for inventive step is described in section C-IV.11 thereof. The guidelines are primarily intended for the examiners of the EPO, however, the EPO deliberately wishes that these should also be of use to the parties to the proceedings and the authorized persons. Examiners can, however, deviate from the guidelines in exceptional cases. However, the parties involved can as a rule assume that the EPO will adhere to the Guidelines until these - or the legal provisions forming the basis thereof - will be amended.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

According to the wording of Sec. 21(1) no. 1 German Patent Act, a German patent will be revoked if it transpires that the subject matter of the patent is not patentable according to Sections 1 through 5 German Patent Act. Thus, it is not possible to apply a different standard to assessing inventive step in granting and opposition proceedings. It is apparent from the reference to Sec. 21(1) German Patent Act made in Sec. 22(1) German Patent Act that the principles regarding the assessment of inventive step in the granting proceedings apply likewise in the nullity proceedings.14 However, with granted patents it must be considered that the burden of substantiating obviousness is in principle on the opponent or nullity plaintiff, while in the granting proceedings (in any case when the Patent Office raises objections) it is the applicant who must show that the claimed subject matter was not obvious to a person skilled in the art.

Pursuant to Art. 100(a) EPC, an opposition against a European patent can be based on the fact that the subject matter of the European patent is not patentable pursuant to Arts. 52 to 57 EPC. Thus, when assessing inventive step the same principles apply in the opposition proceedings before the EPO as in the granting proceedings.

However, in nullity proceedings a court is not bound by decisions in previous (German or European) granting or opposition proceedings. In particular the German part of a European patent can be declared null and void based solely on a prior art which was already the subject matter of opposition proceedings before the European Patent Office.15

In patent infringement proceedings, the defendant cannot defend itself by raising the objection that the patent in suit lacks validity. If an opposition or nullity action is pending against the patent in suit, the court can order, pursuant to Sec. 148 German Code of Civil Procedure, that the proceedings be stayed until the other lawsuit has been resolved. However, the requirement for a stay is a predominant likelihood that the attack will be successful.16 To assess this, patentability pursuant to Secs. 1 to 5 German Patent Act or Arts. 52 to 57 EPC will in the end also have to be considered. To counteract a possible stay, the plaintiff can assert the patent in suit in a restricted scope in the infringement proceedings.17. In this case, the infringement court will also have to take into consideration the question of patentability18.

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[13] http://www.epo.org/patents/law/legal-texts/guidelines_de.html

[14] Nonetheless, the particular situation may arise that older rights may be considered in German nullity proceedings, but not in European opposition proceedings.

[15] FCJ - X ZR 29/93 *Zahnkranzfräser*

[16] Busse/Keukenschrijver, German Patent Act, Sec. 140, marginal no. 6 *et seq*.

[17] FCJ, Judgment of 6 May 2010 – Xa ZR 70/08 – *Maschinensatz* (Higher Regional Court Düsseldorf).

[18] FCJ, Judgment of 6 May 2010 – Xa ZR 70/08 – *Maschinensatz*, marginal no. 49.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

What is decisive is not the wording, but the meaning of a claim. The description and drawings in the patents are used to determined the meaning of a claim. This applies to German patents (sec. 14 German Patent Act) as well as to European Patents (Article 69 EPC).

The use of the description and drawings means that terms in a claim are to be construed as a person skilled in the art understands them based on the entire content of the specification taking into account the technical problem and solution of the invention. In an individual case, a term can have a different meaning within the scope of a particular specification than it normally has in the relevant technical field. When construing a claim in such a case, it is not the general technical jargon that is decisive but instead the meaning that follows from the specification itself[19]. A patent can be "its own lexicon" as it were.

The meaning of a claim is not a question of fact, but rather a question of law. A court must answer this question of law in both infringement and nullity proceedings on its own responsibility by means of an evaluative act. In particular, a court may not simply leave the construction of a claim up to an expert – although, along with the objective technical conditions, the construction must also take into account any prior understanding of the specialists working in the relevant field as well as knowledge, skills and experience and the methodical approach of these specialists[20]. Nor may a court dismiss a patent infringement action on the grounds that the content of a claim is unclear[21].

6. Is it possible to read embodiments from the body of the specification into the claims?

Embodiments of the invention that are described in a specification as being in accordance with the patent normally do not permit any limitation of a claim that generally characterises the invention[22]. For, as a general rule, embodiments only explain an invention as an example and not exhaustively. Thus, a possible meaning of a claim cannot be ruled out for the mere reason that it is not illustrated by an embodiment[23]. However, embodiments are a part of the description and/or drawings that are to be used to determine the meaning of a claim (see question 5 above.).

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

In the case of the prior art, as well, what is decisive is not the wording but rather the meaning according to an expert understanding. In addition to its actual wording, a prior art reference can also disclose what, from the perspective of a person skilled in the art, is obvious for the practice of the teaching described in the reference and, therefore, does not require special disclosure but is instead inferred. However, the fact that what is obvious can be included does not mean that the

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[19] FCJ, GRUR 1999, 909 (911-912) – *Spannschraube*; GRUR 2001, 232 (233) – *Brieflocher*; GRUR 2005, 754 (754) – *werkstoffeinstückig,* BGH – X ZR 23/97 (German Federal Patent Court) – *Extrusionskopf (Mitt. 2000, 105)*

[20] FCJ, GRUR 2009, 1059 (margin no. 38) – *Zerfallszeitmessgerät*

[21] FCJ, GRUR 2009, 653 (margin no. 16) – *Straßenbaumaschine*

[22] FCJ, judgment of 12 December 2006, X ZR 131/02 - *Schussfädentransport*

[23] FCJ, GRUR 2008, 779 (margin no. 34) – *Mehrgangnabe*

disclosure can be supplemented by technical knowledge, e.g. in order to include modifications, enhancements or conclusions[24].

Thus, the case law of the Federal Court of Justice has adopted the view of the EPO's Boards of Appeal, according to which only what, from the perspective of a person skilled in the art, can be "directly and unambiguously" derived is disclosed in a manner that destroys novelty.

8. Do the answers to any of the questions above differ during examination versus during litigation?

It generally does not make a difference whether the construction is carried out for the purpose of assessing patentability, in the granting procedure, opposition or nullity proceedings or in order to examine whether the patent is being infringed[25][26].

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes. A patent can be revoked or annulled if it is obvious with regard to a single document only. During a nullity procedure, the Federal Supreme Court usually asks: "(a) Which steps does the person skilled in the art have to carry out to attain the solution of the patent-in-suit? (b) Did the person skilled in the art have any motivation to make considerations in that direction? (c) What in detail are the reasons in favour or against that the person skilled in the art would have attained the solution of the patent-in-suit based on such considerations?" 27 It is decisive for the assessment of inventive step to consider the documents introduced in the procedure in combination with common technical knowledge.28 In principle, the claimed subject matter can be assessed to be obvious already on the basis of a single prior art, e.g., if this prior art includes a motivation with regard to the claimed subject matter or if it is obvious what has to be done29.

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[24] FCJ, GRUR 2009, 382 (margin no. 25-29) – *Olanzapin*; GRUR 2010, 123 (margin no. 32) – *Escitalopram*; GRUR 2010, 910 (margin no. 62) – *Fälschungssicheres Dokument*

[25] BGH GRUR 2010, 858 (margin no. 13) – *Crimpwerkzeug III*; GRUR 2009, 837 (margin no. 15) – *Bauschalungsstütze*

[26] However, the FCJ points out that the concept of disclosure varies in its function depending on the context. When examining for novelty and for whether the technical teaching of an invention contained in a claim was disclosed in the application as filed, what matters is (as described above) whether a person skilled in the art can directly and unambiguously derive this teaching from the respective text under comparison. However, the situation is different when examining the practicability of an invention or when addressing the question of whether an embodiment contested in the infringement proceedings is protected by a patent. A practicable disclosure or infringement does not require (full) disclosure of an embodiment. Rather it is sufficient, in this context, if a person skilled in the art can, without inventive efforts of his own, fill in gaps and, if necessary, obtain clarity by relying on exploratory tests (FCJ, GRUR 2010, 916 (margin no. 17)– *Klammernahtgerät*).

[27] Benkard, PatG, § 4, Rz. 47

[28] BGH GRUR 1996, 862 – *Bodensegment*

[29] BGH – Xa ZR 92/05 – *Betrieb einer Sicherheitseinrichtung*

In the procedure at the EPO, the so-called “problem-and-solution approach” is applied in order to assess an inventive step30. In the problem-and-solution approach, there are three stages: (i) determining the “closest prior art”, (ii) establishing the “objective technical problem” to be solved and (iii) considering whether or not the claimed invention starting from the closest prior art and the objective technical problem would have been obvious to the skilled person. It is permissible to combine the disclosure of pieces of prior art (e.g. a public prior use or unwritten general technical knowledge) with the closest prior art. In order to exclude a legally inadmissible ex-post-facto analysis, the EPO uses the “could-would approach”. Accordingly, an invention is not yet obvious if the person skilled in the art could have attained it on the basis of the prior art but only if he or she would have proposed it on the basis of a sufficient motivation in expectation of an enhancement or an improvement 31. According to the German Federal Supreme Court, the assessment of the obviousness of a patent-protected subject cannot always be based on the “closest” prior art as the sole point of origin. The choice of a starting point (or of several starting points) needs a particular justification that, as a rule, can be derived from the efforts of the person skilled in the art to find for a certain purpose a better or just another solution than it is provided in the prior art (compare BGHZ 179, 168 numeral 51-Olanzapin).32

The state of the art can be formed by the relevant common general knowledge, which needs not necessarily be in writing and needs substantiation only if challenged.33

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

In contrast to the examination of novelty, no individual comparison is carried out for the examination of the inventive step. Rather, the prior art has to be considered in its entirety (“mosaic-like”)34. Only those disclosures of prior art that the person skilled in the art will consult can be considered for the formation of a mosaic35. The recent case law of the Federal Supreme Court regularly focuses on the question whether the skilled person based on a disclosure of prior art had a motivation to attain the subject matter of the invention 36. It appears to be consistent to request such a motivation for the combination of two documents as well.

In particular, a combination of two or more different disclosures is possible if it is likely that the person skilled in the art would link them due to their content when studying the problem solved by the invention. It can be expected that the skilled person looks for motivations also in neighbouring fields and common technical fields37 or even in remote fields of technology if he has a motivation for that38, 39. The linking of two or more parts of the same disclosure would be obvious if there is any clue for the skilled person to link these parts.

However, the fact that more than one disclosure has to be combined with the closest prior art in order to attain a combination of features can be a sign of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features. In determining whether it would be obvious to combine two or more distinct disclosures it has to be considered whether the content of the disclosures (e.g. documents) is such to make it likely or unlikely that the person skilled in the art, when faced with the problem solved by the invention, would combine them, or whether the disclosures come from similar, neighbouring or remote technical fields. (Guidelines C-IV, 11.6)

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[30] Guidelines for Examination at the EPO, C-IV, 11.5
[31] Busse/Keukenschrijver, PatG, § 4 Rdnr. 145
[32] BGH – Xa ZR 138/05 - *Fischbißanzeiger*
[33] T939/92, Abl. 6/1996(Ri-Li C-IV, 11.2)
[34] Busse/Keukenschrijver, PatG, § 4 Rdnr. 32
[35] Busse/Keukenschrijver, PatG, § 4 Rdnr. 33
[36] BGH Decision of 30.4.2009, Xa ZR 92/05 – *Betrieb einer Sicherheitseinrichtung*
[37] T 176/84, ABl. 2/1986, 50, T 195/84, ABl. 2/1986, 121
[38] T 560/89, ABl. 12/1992, 725
[39] BGH, Decision of 31 August 2010 – X ZR 73/08 – *Gleitlagerüberwachung* (Bundespatentgericht)

However, the finding of a new teaching for technical actions cannot be assessed as not being based on an inventive activity if merely no obstacles are present to attain to the subject matter of this teaching based on the known prior art. Instead, this evaluation requires that the known prior art gave a reason or motivation to attain to the proposed teaching40.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

For answering the question whether the combination of two or more distinct disclosures is obvious, the examiner of the EPO verifies in particular whether the disclosures are from similar, neighbouring or remote technical fields. It can be expected that the skilled person searches for motivations in neighbouring and common technical fields41 or even in remote fields of technology, if he has any motivation 42, in particular, if "according to the kind of the problems that arise there, in principle, solutions can be expected as they are needed".43

According to the case law of the Federal Supreme Court it is also of importance, how similar or close-by the technical fields are. Recourses on insights from other fields of technology are definitely possible in particular cases. Hence, the consultation of experts or of other better qualified skilled persons or inquiries to the relevant skilled person can be expected if the problem to be solved arises in a close-by field of technology in a similar way for if he or she recognises on the basis of his or her own knowledge that he or she may find a solution in another field. 44.

According to the recent German practice the problem formulated in the application or patent specification is not suitable for the determination of the inventive step. 45 Rather it is focussed on the question what the claimed solution actually achieves vis-à-vis the prior art. 46 In contrast, the EPO case law relies on the problem-solution-approach for the assessment of inventive step as already mentioned above.

In particular cases, the problem can supportively substantiate the inventive step and can be an indication for the presence of an inventive step, for example, if the creation of a problem would not have been possible for the skilled person who knows all common problems. 47 However, problems that are common to the skilled person can never support an inventive step.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

In the context of the problem-solution approach, it is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art with the closest prior art. A fixed upper limit for the number of documents that has to be exceeded as an indication for the presence of an inventive step, does not exist. However, the fact that more than one disclosure

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[40] BGH, Decision of 08.12.2009 – X ZR 65/05 (BPatG) – *einteilige Öse*
[41] T 176/84, ABl. 2/1986, 50, T 195/84, ABl. 2/1986, 121, BGH Xa ZR 69/06 – *Telekommunikationseinrichtung*
[42] T 560/89, ABl. 12/1992, 725
[43] BGH X ZR 49/09 – *Ziehmaschinenzugeinheit II*
[44] BGH Decision of 29.9.2009, X ZR 169/07- *Diodenbeleuchtung*
[45] BGH Bausch 1994/98, 159, 166 – Betonring; GRUR 2005, 141, 142 – *Anbieten interaktiver Hilfe*
[46] Benkard/Asendorf/Schmidt, PatG, § 4 Rdnr. 12
[47] BPatGE **21**, 43, 47; **32**, 25, 28; T0225/84; T0645/88; T0301/89

must be combined with the closest prior art in order to attain a combination of features can be a sign of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features48. At least if none of the three or more combined documents forms part of the common technical knowledge it will in general be difficult to show the necessary motivation for a combination of three documents without making use of a ex-post-facto-analysis.

13. Do the answers to any of the questions above differ during examination versus during litigation?

As already mentioned above, in a patent infringement procedure defendant cannot defend himself by the objection of a lack of validity of the patent-in-suit. The principles for the assessment of the inventive step are used in the same way in the examination, opposition and nullity procedure. Hence, there is no room for different ways to proceed regarding the combination of published documents. However it has to be pointed to the differing distribution of the burden of proof in the examination, opposition and nullity procedure.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The objective technical problem plays an important role in examining whether the teaching according to the patent was obvious:

As part of the "problem-solution approach" applied by the EPO, one must examine whether the prior art contains suggestions that would (not only could, but would) cause a person skilled in the art who is dealing with this technical problem to take the approach according to the patent ("could/would approach"[49]). However, the applicant's subjective ideas, such as, for example, the mention of a certain technical problem in the description and its assignment to a certain claim, do not help determine the claimed subject matter.[50]

The FCJ also assumes a technical problem that has been objectively solved (contribution to the art) and examines whether the prior art offers suggestions for seeking the solution to the technical problem by means of the invention.[51]

However, the technical problem on its own is not an invention. The invention can only lie in its solution.[52]

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The objective technical problem does not have to be explicitly mentioned in the description. However, according to Rule 42 (1) c) of the *Implementing Regulations to the European Patent Convention 2000*, the description shall disclose the invention in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood. Yet, non-compliance with this rule is not a ground for opposition or nullity *per se*.

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[48] Guidelines for Examination at the EPO, C-IV, 11.6
[49] *Guidelines for Examination in the EPO* [as at 1 April 2010], part C IV 11.5.3
[50] FCJ – X ZR 23/97 (German Federal Patent Court) – *Extrusionskopf*
[51] FCJ GRUR 2009, 746 – *Betrieb einer Sicherungseinrichtung*; GRUR 2010, 607 – *Fettsäurezusammensetzung*; GRUR 2010, 407 – *einteilige Öse*
[52] FCJ GRUR 1984, 194 – *Kreiselegge*

The EPO and the FCJ agree that the technical problem as specified in the description is not binding, but that the technical problem is to be determined in an objective manner. However, the EPO and BGH use different approaches when making this objective determination:

According to the *Guidelines for Examination in the EPO* (as at 1 April 2010), part C IV 11.5.2, in order to establish the technical problem, one studies the application (or the patent), the closest prior art and the difference (also called the distinguishing feature(s) of the claimed invention) in terms of the features (structural or functional) between the claimed invention and the closest prior art, identifies the technical effect resulting from the distinguishing features, and then formulates the technical problem. In order to avoid an ex post facto view being taken, the technical problem must be formulated in such a way that it does not contain any pointers to the technical solution. Whether a reformulation of the technical problem is necessary depends on the facts. Generally, any effect of the invention can be used as a basis for the reformulation of the technical problem, provided that the corresponding effect can be derived from the application in the version originally submitted[53]. New effects which the applicant first reports on in the proceedings can also be taken into account, provided that it is apparent to a person skilled in the art that these effects are implied in or related to the technical problem initially suggested[54] [55]. However, subjective ideas of the Applicant do not help determine the claimed subject matter[56]; nor do they help determine the objectively solved technical problem to be taken into account with respect to the inventive activity.

Ineffectiveness of a prior art device – or of such a procedure – that is not discovered or alleged until after the priority or filing date cannot be used for formulating the technical problem[57]. For, what is decisive when assessing the inventive step is the knowledge of a person skilled in the art on the priority or filing date. Yet, in any case in the field of chemistry and biotechnology it is not unusual for the results of comparative tests carried out after the priority or filing date to be referred to – to make a prima facie case for the technical problem that has been objectively solved and therefore to assess the inventive step.

Knowledge that does not arise until after the filing or priority date may not be used to form the technical problem.[58]

The FCJ's approach does not attach special significance to the closest prior art when determining the "problem" (the technical problem that has been objectively solved). According to the FCJ (GRUR 2010, 602 – *Gelenkanordnung*), determining the technical problem on which a patent is based is part of the interpretation of the claim. Statements in the description of the patent that concern the "technical problem" of the invention can contain a reference to the correct understanding of the claim. However, with respect to such statements – and with respect to the entire remaining content of the specification – the claims of the patent are decisive. The technical problem must be developed from what the invention actually achieves. Non-technical specifications are to be attributed (if at all) to the technical problem and not to the solution of the problem[59].

Advantageous effects

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[53] see T 386/89, not published in the OJ
[54] see IV, 11.11 and T 184/82, OJ 6/1984, 261
[55] *Guidelines* C-IV, 11.5.2
[56] FCJ – X ZR 23/97 (German Federal Patent Court) – *Extrusionskopf*
[57] T 0268/89, OJ 94, 50
[58] T 0268/89, OJ 94, 50
[59] FCJ GRUR 2010, 44 – *Dreinahtfolienschlauchbeutel*, margin no. 14; BGH 26.10.2010, - X ZR 47/07 - *Wiedergabe topografischer Informationen* margin no. 39

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantageous effects of the invention that the skilled person could have expected based on the prior art are generally indications in disfavour of an inventive step, since they represent a reason to modify the prior art into a direction of the invention. However, unexpected and surprising advantageous effects have to be distinguished as to whether they belong to an objective contribution of the invention with regard to prior art and, therefore, have to be incorporated in the problem-solution-approach, or whether they are a bonus effect due to the application of a measure that is per se obvious. In the latter case they are part of the auxiliary criteria (previously: “indications of evidence”) that are used for the assessment of inventive step according to German law and according to EPO case law, but that cannot reason the inventive step nor replace it taken alone.60 In individual cases these auxiliary criteria can give a reason to verify very critically solutions that are known in prior art as to whether they give sufficient indications for an obviousness of the subject matter of the invention vis-à-vis the common technical knowledge and do not appear to include a motivation leading to the invention merely in an ex-post-facto analysis. 61 Every consideration with regard to inventive step has to orient along the wording of Art. 4 of the German Patent Act and Art. 56 EPC according to which an invention is considered to be based on an inventive step if it is not obvious to a skilled person in view of the prior art. Therefore, the standard of examination for the inventive step is not any degree of inventive merit but solely the answer to the question whether or not the invention is obvious for the skilled person. A new directive for technical actions is obvious if the known prior art gave a motivation or a reason to the skilled person to attain the new teaching. 62 However, it is not sufficient that the new teaching does not have any advantageous effects. Advantageous effects that are a necessary result of an obvious measure and that are a windfall profit for the skilled person without any own inventive activity cannot contribute to the adjudication of an inventive step. (compare case law of EPO with regard to “bonus effects”).

17. Must the advantageous effects be disclosed in the as-filed specification?

Generally, the skilled person can rely on advantageous effects for the assessment of an inventive step even if these effects are not mentioned in the original application documents but implicitly result from the application only. However, this approach reaches a limit when an entirely new problem is proposed based on the (not disclosed) advantageous effects as a basis for the invention. A change of the problem in such a way is not accepted by the boards of appeal of the EPO.

Hence, care is required if new effects are mentioned to support an inventive step. Such new effects can only be considered if they are implicit in the original problem as it results from the application as originally filed or if the new effects are at least related to it. 63,64

The assessment according to German practice is similar. Advantages and precious characteristics have to be originally disclosed if they are used to reason an inventive step. 65

“Advantages not mentioned in the patent specification or advantages that are not recognizable for the skilled person on the basis of his or her technical knowledge at the priority date cannot be

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[60] BGH, GRUR 1991, 120 - *elastische Bandage*; GRUR 2007, 997 - *Wellnessgerät*
[61] BGH, GRUR 2010, 44 - *Dreinahtschlauchfolienbeutel*
[62] BGH, GRUR 2010, 407 - *Einteilige Öse*
[63] Guidelines for Examination at the EPO, C IV, 11.5.2, T 386/89, nicht im ABl. veröffentlicht, und T 184/82, ABl. 6/1984, 261
[64] Guidelines for Examination at the EPO, C-IV, 11.11
[65] Schulte § 34, Rn 399, referring to BGH GRUR, **60**, 543, *Flugzeugbetankung*

considered for the assessment of an inventive step" 66. Advantages that give the invention its actual meaning if they are used cannot be considered. 67

18. Is it possible to have later-submitted data considered by the Examiner?

Advantageous effects that are disclosed in the application as originally filed or advantageous effects that are at least implicitly disclosed in the application can be proved by later filed data, results of comparative tests etc.

However, a later inclusion of the advantageous effects in the application documents is not admissible according to the permanent and long standing practice of the EPO and German Patent and Trademark Office. Such results are merely taken to the file and on the first page of the patent specification it will mentioned that the files of examination contain technical information that has been submitted after the filing date of the application.

19. How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?

The advantageous effects have to be plausible. In individual cases a theoretical example can be sufficient for furnishing a prima facie evidence.

In certain cases later filed examples and new effects, even if they cannot be included in the application, can be considered by the examiner as an evidence to support patentability of the invention as claimed. For example, an additional example can be considered as an evidence that the invention can be practiced in the entire range as claimed without further ado using the details in the application as originally filed. 68 A new effect 69 can also be considered as an evidence to support an inventive step if the new effect is implicit in an effect that is disclosed in the application as originally filed or if it is at least related to it. 70, 71

20. Do the answers to any of the questions above differ during examination versus during litigation?

Answers to questions 16 to 19 are the same independent of whether the inventive step is assessed at the patent offices (German Patent and Trademark Office and EPO) or the relevant courts (German Federal Patent Court, German Federal Supreme Court, infringement courts).

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

If the state of the art suggests another approach than the patent application or the patent ("teaching away"), that speaks in favour of the fact that the skilled person had no motivation to

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66 Benkard, a.a.O., § 4, Rdnr. 56, BGH – *Hubwagen*, GRUR 1971, 403
67 Benkard, a.a.O., § 4, Rdnr. 56, BGH – *Flugzeugbetankung*, GRUR 1960, 542, BGH – *Einlegesohle*, GRUR 1962, 83
68 Guidelines for Examination EPO, C III, 6.3
69 Guidelines for Examination EPO, C VI, 5.3.4, the effect mentioned there
70 Guidelines for Examination EPO, C IV, 11.10
71 Guidelines for Examination EPO, C VI, 5.3.5

follow the way of the application or the patent[72]. However, such circumstance of the case is not just given due to the fact that the claimed subject matter is based on balancing advantages against drawbacks with respect to the state of the art[73], or that a drawback is merely accepted[74].

On the other hand, an inventive step cannot be affirmed only in cases where the skilled person finds indications which cause him to proceed in another way than that of the invention, but it will normally be affirmed if he does not find hints or motivations for further developing the state of the art in the direction of the invention. Consequently, it is not necessary that the state of the art explicitly advises the skilled person to follow a technical teaching which is not consistent with the teaching of the invention, if the teaching of the invention shall be assessed as not obvious.

It can be assessed as a positive indicator of evidence for an inventive step, if the technical development went into another direction before the date of the application, in particular if paths have been taken which lead away from the invention, or if a successful renunciation from a hitherto conventional concept is proposed[75].

A renunciation of commonly used paths shall also be considered when assessing an inventive step[76].

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

In contrast to other secondary criteria, information in the state of the art which prevents the skilled person from further developing the state of the art in the direction of the invention, are strong indicators that the invention is not obvious from the state of the art.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No. Indications in the state of the art which cause the skilled person to further develop the state of the art in another direction than the invention have the same impact in examination proceedings and in judicial disputes.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

According to German law as well as in the practice of the European Patent Office, secondary considerations can be considered for assessing the inventive step. In fact, they may offer an indication against obviousness in individual cases, but they cannot substitute the evaluation of the content of the state of the art[77]. Only in individual cases, they may cause for a particularly critical examination of known solutions, whether these solutions comprise indications for obviousness of

[72] BGH – X ZR 115/96 – *Stoßwellen – Lithotripter*, BGH Xa ZR 92/05 – *Betrieb einer Sicherheitseinrichtung*
[73] BGH X ZR 24/03 – *Mikrotom*
[74] BGH X ZR 49/94 - *Rauchgasklappe*
[75] T 229/85, T 221/86
[76] BGH GRUR 99, 145 *Stoßwellen-Lithotripter*
[77] BGH, GRUR 2007, 997 - *Wellnessgerät*; BGH, GRUR 1991, 120 - *Elastische Bandage;* BGH, Urteil vom 29. Juni 2010 – X ZR 49/09 – *Ziehmaschinenzugeinheit II*

the invention in view of the common technical knowledge, and not only from an ex-post view seem to comprise an indication which leads to the invention[78].

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

Secondary considerations which are most often applied are[79]:

a) An economic success, which is (essentially) based on the invention of the patent in dispute (and not on other factors like e.g. marketing)
b) Overcoming difficulties
c) Satisfaction of a long lasting need
d) Evidence of attempts of others which were in vain
e) Unexpected technical progress like improvement, simplification, cost savings
f) Overcoming prejudices
g) Momentum of time[80]
h) Unexpected, surprising result
i) Deviation from the paths hitherto taken[81]

If one refers to secondary considerations, they have to be proven. Which evidence is most convincing depends on which secondary considerations the patent applicant or the patent owner refers for the evidence of the inventive step. Evidence is for example citations, expert opinions, results of comparative experiments, turnover before and after the subject matter of the invention has been introduced on the market, license revenues, praising comments among experts, etc. There must be a demonstrable causal relationship between the secondary considerations and the claimed invention.

26. Do the answers to any of the questions above differ during examination versus during litigation?

The answers to the questions 24 and 25 apply to the examination, opposition and invalidity proceedings as well as to litigation.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

Before it is actually evaluated whether the proposed technical teaching is based on an inventive step, the subject matter of the patent, the appropriate skilled person and the relevant state of the art are determined.

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[78] BGH, GRUR 2010, 44 – *Dreinahtschlauchfolienbeutel*
[79] Pagenberg, Beweisanzeichen auf dem Prüfstand - Für eine objektive Prüfung auf erfinderische Tätigkeit, GRUR Int. 1986, 83ff
[80] BGH, Urteil vom 29. Juni 2010 – X ZR 49/09 – *Ziehmaschinenzugeinheit II*
[81] BGH GRUR 1999, 145- *Stoßwellen-Lithotripter*

The subject matter of the patent is defined by the patent claims, which can be interpreted by the description and the drawings. Terms used in the claims have to be interpreted in the same way like the skilled person who is addressed understands them while taking into account the objective solution disclosed therein[82].

The appropriate person skilled in the art, whose view is relevant, is considered to be a fictive person, who is working in the field of the invention and who has average knowledge, experience and competences. The appropriate skilled person has average expertise and skills. The expertise has to be demonstrated by published state of the art and the expertise and skills have to be demonstrated by textbooks, models, drawings or other materials, i.e. by materials which show reliable indications about the actual knowledge and skills of the person skilled in the art at the priority date. The skilled person in charge is not necessarily a single person. If it is useful, the appropriate person skilled in the art will consult a second skilled person or work within a team[83].

During examination of the inventive step, the "state of the art" is deemed to be the complete state of the art (with the exception of prior applications), which is also the basis for the examination of novelty. A mosaic like synopsis of the state of the art is the basement, from which the inventive step has to be assessed. It is not sufficient that the invention is inventive in view of single citations. Only the synopsis of the state of the art can also disclose wrong technical beliefs – which probably have been overcome by the invention – or the course of the technical development. The closest state of the art which is named in the patent publication is merely understood as a possible initial point for inventive thoughts of the person skilled in the art, but not as a determination. In some cases, several initial points are possible and have to be investigated, because there is no sole closest state of the art. In the opinion of the Federal Court of Justice, the choice of an initial point (or also several initial points) needs a particular justification, which is regularly to be derived from the effort of the person skilled in the art to find for a specific purpose a better – or just another – solution than that which is provided by the state of the art (see BGHZ 179, 168 Tz. 51 – Olanzapin). In the opinion of the Federal Court of Justice, neither the German Law nor the European Patent Convention provides a basis to apply solely a "closest" state of the art[84].

If yes, please describe these issues, tests, or factors.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

For judging the inventive step, the European Patent Office uses nearly without exception the so called problem solution approach. It is structured in three phases:

a) Identification of the "closest state of the art"
b) Determination of the "objective technical problem" to be solved, and
c) Examination of the question, whether the claimed invention would have been obvious for the skilled person in view of the closest state of the art and the objective technical problem.

[82] BGH, GRUR 2001, 232 - *Brieflocher*
[83] Schulte, Patentgesetz mit EPÜ, 8. Auflage, § 4, Rdn. 39-41; Richtlinien für die Prüfung im EPA, Teil C - Kap. IV 11.3
[84] BGH, GRUR 2009, 1039 - *Fischbissanzeiger*

In the third phase it has to be clarified whether there is a teaching in the state of the art as a whole, which would cause the skilled person who is working on the objective technical problem, to modify or adapt the closest state of the art in view of that teaching, and thus to arrive at something which falls under the patent claim, and to achieve what is achieved by the invention[85].

The Federal Court of Justice regards the "problem solution approach" insofar critically, as it requests already in a first step the choice of the closest state of the art, because the closest state of the art can only be determined ex post being aware of the invention. Only in a retrospective view it will become visible which prior publication comes closest to the invention, and how the developer could have approached in order to arrive at the solution of the invention. Therefore, the choice of the initial point needs the justification, which is normally given by the effort of the skilled person to find a better solution for a particular purpose than the solution which is provided by the state of the art[86]. Therefore, in the view of the Federal Court of Justice, the "closest state of the art" cannot always be taken as sole initial point when judging the obviousness of a patented subject matter[87]. For the Federal Court of Justice, the answers to the following questions are relevant for assessing the inventive step (see questions of evidence of the Federal Court of Justice in the invalidity appeal procedure):

a) Which steps the skilled person had to perform in order to arrive at the teaching of the patent in dispute?
b) To what extent the skilled person had a motivation to make considerations in this direction?
c) What in detail argues for or against the fact that the skilled person would have arrived at the solution of the patent in dispute on the basis of such considerations?

According to German law, the appraisal whether the invention was obvious or not is finally always necessary, including a synopsis of all relevant citations in consideration of the knowledge and the competence of the person skilled in the art.

29. Does such test differ during examination versus during litigation?

As discussed above with respect to question 28, the methods of assessing the inventive step do not differ in their application in the European and German proceedings.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

No further cases apart from question 29 (EPO vs FCJ).

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

The different approach of the EPO and the German Federal Patent Court/FCJ can result in divergent decisions, for example where the patent is initially maintained in the opposition

[85] Richtlinien für die Prüfung im EPA, Teil C - Kap. IV 11.5.3
[86] BGH, GRUR 2009, 28 Rdn. 51 - *Olanzapin*
[87] BGH, GRUR 2009, 1039 - *Fischbissanzeiger*

proceedings before the EPO and then contested by a nullity action before the German Federal Patent Court/FCJ.

A European patent can also be nullified (possibly only) due to prior art that has already been taken into account in opposition or opposition appeal proceedings before the EPO relating to the same patent.[72]

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

Yes (see answers to questions 28 and 29)

33. If yes, is this problematic?

Yes, because this can lead to different assessments of the question of the inventive step.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?
36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.
37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

In the opinion of the German Committee, the problem solution approach which is usually applied in the practice of the European Patent Office is for the large majority of the cases a practical approach for the test of the existence of an inventive step. It is based on the legal definition in Art. 56 EPC (European Patent Convention) or § 4 PatG (German Patent Law), according to which an invention is deemed to be based on an inventive step if it is not obvious from the state of the art for a person skilled in the art[89]. As it is generally known, the problem solution approach is structured in three phases:

i) Identification of the “closest state of the art” und the objective differences to the claimed solution
ii) Determination of the “objective technical problem” to be solved, and

[72] FCJ GRUR 96, 757 *Zahnfräser*
[89] see question 1

iii) Examination of the question, whether the claimed invention would have been obvious to a skilled person in view of the closest state of the art and the objective technical problem.

In phase ii), objective distinctive features between the claimed invention and a particular prior published document which comes close to the invention will be determined, and from the determination of the distinctive features it will be derived which problem has been solved "objectively" in view of this difference. In phase iii) it has to be clarified in accordance with the so-called "could-would approach", whether the skilled person on the one hand had the technical possibilities to carry out the invention ("could"), and whether he would have proposed it on the basis of the state of the art, his expertise and his skills as the solution of the problem ("would"). In this context it has to be examined whether the skilled person, taking into consideration the objective technical problem, had a motivation to amend a particular state of the art, which forms the initial point of his considerations, in a way that he arrives at something which falls under the patent claim, and achieves something which is achieved by the invention. The determination of the inventive step in this way has to be the result of a judgmental consideration – prospective – from the perspective of the skilled person who is usually involved in the problem on the priority date, where it mainly will have to be considered which motivations he gained from the further state of the art.

A certain difficulty of this method is given by the fact that the bodies which are handling this question (courts, granting authorities), in practice have to put themselves in a person (the "person skilled in the art"), who owns other knowledge and skills than they do, and thus have to conduct that judgemental consideration at a foreign measure. This judgemental consideration thus is a legal question and not a question of facts, and therefore should in general not be subject to an offer for evidence (different from the initial point for the assessment of the inventive step derived from actual indications, the determination of the knowledge and skills of the person skilled in the art)[90].

In the opinion of the German Committee it is a central point for the assessment of the inventive step to avoid a retrospective view (being aware of the invention). Because ex-post – well knowing the invention – many things seem simple which were not visible without such knowledge (in particular with the beliefs prevailing in the state of the art, which have been overcome initially by the invention).

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Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer. If possible type your answers in a different colour. Thank you for your assistance.

[90] see the Resolution AIPPI Q213

Summary

According to Article 56 Sentence 1 EPC, an invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. In this regard, a key criterion for the Federal Court of Justice is whether a person skilled in the art was *prompted* in any way to develop the state of the art along the lines of the subject-matter of the invention.

When examining for inventive step, the European Patent Office applies the “problem-and-solution approach”, in which the first step involves determining the closest prior art. In a second step, the features which objectively distinguish the claimed invention from a specific previously published document close to the invention are determined, and on the basis of these distinguishing features the objective technical problem to be solved is established. In a third phase, it must then be clarified whether a person skilled in the art had the technical possibility of carrying out the invention and whether he *would* have proposed it, on the basis of the prior art and his technical knowledge, as a solution to the problem (“*would have*” as opposed to “*could have*”).

In the view of the German Group, the problem-and-solution approach used by the European Patent Office is a practical point of departure for examining whether an inventive step is involved. The establishment of inventive step in this way must be be result of an *evaluational*, prospective approach – from the perspective of the skilled person who is normally faced with the stated problem addressed by invention on the date of priority. It is essential to avoid any retrospective approach (based on knowledge of the invention). This evaluational approach is therefore a legal question and for that reason is not amenable to discovery. However, examiners and judges need to be particularly well trained to perform this difficult evaluation and arrive at objectively correct conclusions.

Zusammenfassung

Gemäß Art. 56 Satz 1 EPÜ, § 4 Satz 1 PatG gilt eine Erfindung als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt. Der Bundesgerichtshof stellt in diesem Zusammenhang insbesondere darauf ab, ob der Fachmann eine *Anregung* hatte, den Stand der Technik in Richtung des Erfindungsgegenstandes weiterzuentwickeln.

Das Europäische Patentamt verwendet im Rahmen der Prüfung des erfinderischen Schrittes den so genannten "Aufgabe-Lösung-Ansatz". Hiernach ist in einem ersten Schritt der nächstliegende Stand der Technik zu ermitteln. Sodann werden in einem zweiten Schritt die objektiven Unterscheidungsmerkmale zwischen der beanspruchten Erfindung und einem bestimmten der Erfindung nahe kommendem vorveröffentlichten Dokument bestimmt und anhand dieser Unterscheidungsmerkmale die der Erfindung zugrundeliegende Aufgabe ermittelt. In einer dritten Phase ist dann zu klären, ob der Fachmann einerseits die technischen Möglichkeiten hatte, die Erfindung auszuführen, und andererseits, ob er sie auf Grundlage des Standes der Technik und seines Fachwissens als Lösung der Aufgabe vorgeschlagen haben *würde* (nicht auf „*hätte können*“, sondern tatsächlich „*haben würde*“).

Nach Ansicht der deutschen Landesgruppe stellt der Aufgabe-Lösung-Ansatz des Europäischen Patentamtes im Ausgangspunkt einen praktikablen Zugang zur Prüfung der erfinderischen Tätigkeit dar. Die Bestimmung der erfinderischen Tätigkeit muss auf diesem Wege das Ergebnis einer *wertenden* Betrachtung – prospektiv – aus der Perspektive des üblicherweise mit der Aufgabe der Erfindung am Prioritätstag befassten Fachmanns sein. Eine rückschauende Betrachtung (mit Kenntnis der Erfindung) ist zu vermeiden. Diese wertende Betrachtung ist somit eine Rechtsfrage und damit einem Beweisangebot nicht zugänglich. Zur Erzielung sachgerechter Ergebnisse bedarf es allerdings für diese schwierige Bewertung besonders gut geschulte Prüfer bzw. Richter.

Résumé

Selon l'article 56 CBE phrase 1 et le § 4 phrase 1 de la loi allemande sur les brevets, une invention est considérée reposer sur une activité inventive si elle ne découle pas, pour l'homme du métier, d'une manière évidente de l'état de la technique. Dans ce contexte, la Cour fédérale se base en particulier sur le fait de savoir si l'homme du métier a été *incité* à perfectionner l'état de la technique en direction de l'objet de l'invention.

L'Office Européen des Brevets utilise, dans le cadre de l'examen de l'activité inventive, ce qu'il est convenu d'appeler "l'approche problème-solution". D'après celle-ci, il faut, lors d'une première étape, déterminer l'état de la technique le plus proche. Ensuite, lors d'une seconde étape, les caractéristiques distinctives objectives entre l'invention revendiquée et un document défini déjà publié qui se rapproche de l'invention et le problème technique objectif sur lequel repose l'invention est déterminé à l'aide de ces caractéristiques distinctives. Dans une troisième phase, il faut alors tirer au clair si l'homme du métier avait, d'une part, les possibilités techniques de réaliser l'invention et, d'autre part si, sur la base de l'état de la technique et de ses compétences techniques, il *l'aurait* proposée comme solution au problème technique objectif (non pas il „*aurait pu*“ mais il „*l'aurait*“ effectivement fait).

Du point de vue du groupe de langue allemande, « l'approche problème solution » de l'Office Européen des Brevets constitue, dans son point de départ, une approche praticable pour l'examen de l'activité inventive. La détermination de l'activité inventive doit être de cette manière le résultat d'une considération *d'appréciation* – prospective – à partir de la perspective de l'homme du métier qui examine habituellement le problème technique objectif de l'invention le jour de la priorité. Une considération de manière rétrospective (avec connaissance de l'invention) doit être évitée. Cette considération d'appréciation est donc une question de droit et ne relève pas de l'apport de preuves. Toutefois, pour obtenir des résultats appropriés à l'état de fait, on a besoin, pour cette appréciation difficile, d'examinateurs ou encore de juges particulièrement bien formés.